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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,997	10/12/2000	Olivier De Lacharriere	196726US0	5836

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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED: 1/21/03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
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Due Date(s): 4/15/03

Office Action Summary

Application No.

09/686,997

Applicant(s)

DE LACHARRIERE ET AL.

Examiner

Michael A. Willis

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 16-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 16-24 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Applicant's amendment of 4 October 2002 is entered. Claims 14 and 25 are cancelled. Claims 12 and 23 are amended. Claims 12-13, 16-24, and 27-33 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

All previous rejections are withdrawn.

The following new grounds of rejection are made:

Claim Rejections - 35 USC § 112

Claims 12-13, 16-24, and 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 23 are rejected for being confusing due to the listing of 5-androstene-3 β ,17 β -diol as a metabolic derivative of DHEA and 5-androstenediol as a biological precursor of DHEA. The examiner accepts that 5-androstene-3 β ,17 β -diol is a metabolic derivative of DHEA. However, 5-androstenediol is merely an alternate name for 5-androstene-3 β ,17 β -diol (i.e. CAS Registry Number 521-17-5). Therefore, it is confusing that a compound is listed as both a biological precursor and a metabolic derivative.

Any remaining claims are rejected for depending from an indefinite base claim.

Claim Rejections - 35 USC § 103

Claims 12-13, 16-19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breton et al (US Pat. 5,900,242).

The claims are directed to methods of depigmenting and/or bleaching for the skin and/or to improving the homogeneity of the color of the skin, comprising applying DHEA or a specifically named precursor or metabolite thereof, including DHEA sulfate, also known as S-DHEA.

Breton teaches compositions comprising S-DHEA and methods of use thereof. The compositions comprise up to 5% S-DHEA (see claims 6-8). The compositions further comprise sunscreens, retinoids, and hydroxyacids, meeting the limitation of UV screening agents and keratolytic agents (see col. 3, lines 26-42; and claim 2). The reference lacks the exact phrase of "depigmenting and/or bleaching for the skin and/or to improving the homogeneity of the color of the skin".

While the reference lacks the exact same wording as the instant claims, the reference teaches a method for reviving the radiance of human skin (see col. 2, lines 1-15, and claim 1). The reference teaches that the signs of aging include "yellowing of the skin which becomes duller and loses its radiance" (see col. 1, lines 18-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have understood Breton's teaching of a method of reviving the radiance of human skin as being a method of depigmenting and/or bleaching for the

skin and/or to improving the homogeneity of the color of the skin. The motivation for this comes from Breton's teaching that a loss of radiance is equivalent to yellowing of skin. Restoration of the radiance of skin means that the yellowness is removed or bleached away, or at least made more homogeneous.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-13, 16-18, 23-24, and 27-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 36-38 of U.S. Patent No. 6,486,147. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are directed to methods for improving the homogeneity of the color of the skin and/or for lightening the skin, as well as a method of treating canities (gray hair) by applying a composition comprising DHEA, or a precursor or metabolite thereof.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelson (US Pat. 6,149,933) discloses compositions for promotion of healthy hair and pigment restoration to gray hair. Example 6 comprises DHEA. However, the method taught by Nelson is through oral dosage rather than applying the composition to superficial body growths as claimed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1617

maw
January 7, 2003


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200 7600